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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,588	08/20/2003	Connie Sanchez	05432/100M919-US3	5265

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EXAMINER	
BETTON, TIMOTHY E	
ART UNIT	PAPER NUMBER
1617	

MAIL DATE	DELIVERY MODE
09/04/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/644,588	SANCHEZ ET AL.	
	Examiner	Art Unit	
	TIMOTHY E. BETTON	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 August 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21,25,27,31,33 and 37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21, 25, 27, 31, 33, and 37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Response to Remarks

Applicants Remarks filed on 7 August 2008 have been received and duly made of record. Examiner also acknowledges the Yevtushenko et al. reference filed on 7 August 2008.

The essence of applicants' response is directed to the applicants' assertion that Svensson does not adequately address the inventive objective of the claimed invention by being drawn to *advertising claims* as termed by applicant. However, Svensson adequately teaches that Escitalopram was known to be the active isomer of the antidepressant citalopram. Svennson teaches a target population in association with established criteria drawn to depression.

Patris teaches citalopram (which contains the S-enantiomer). However Boegesoe et al explicitly teach the entire 5-HT uptake inhibition resides in the (+) enantiomer (escitalopram). Boegesoe also teach embodiments of dosages which fully encompass the limitations of claimed invention. In further consideration of the teachings of Bilski, the said reference is withdrawn.

The limitations of claims 27, 31, 33, and 37 which are all drawn to a pharmaceutically acceptable salt as a crystalline oxalate salt is merely functional language attributed to the S-enantiomer of citalopram (i.e., escitalopram).

Regarding MADRS data, the Examiner asserts that applicant purports surprising and unexpected results based on an insufficient disclosure of a value drawn to a well-established test. The limitation of a score of at least 29 according to MADRS is significant based on the claimed scope of invention. Granted, as MADRS is well-known in the pertinent art, it is not apparent from the claimed invention if the applicant is establishing this score as a nexus for applicants' inventive objective drawn to the purported effectiveness of escitalopram.

For the reasons of record, the 103(a) rejection is maintained.

Rejections not reiterated from previous Office Actions are hereby withdrawn. The following rejections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7 February 2008 has been entered.

IDS considered

The IDS as filed on considered, in accordance with 37 C.F.R. 1.97, as it is filed after (A), (B) and (C) above, but before payment of the issue fee:

Applicant petitions under 37 C.F.R. 1.97(d) for the consideration of this IDS.

Under 37 CFR 1.17 it is indicated [...] first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this IDS.

Status of the claims

Claims 23, 29, and 35 were canceled in the Response filed on September 27, 2007. Claims 21, 25, 27, 31, 33, and 37 are pending for further prosecution on the merits.

Claim Rejections - 35 USC § 103(a)

(New Grounds of Rejection)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 21, 25, 27, 31, 33, and 37 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Patris M, et al. ("Citalopram versus fluoxetine; a double-blind, controlled, multicentre, phase III trial in patients with unipolar major depression treated in general practice," 1996 International Clin Psychopharm 11: 129-136), in view of Boegesoe et al. (US Pat. 4,943,590), and further in view of Maisey et al. (US Pat. 4, 079,135).

Patris et al. teach the administration of citalopram in the treatment of patients with major depression (abstract). Patients had a score of 30 on the MADRS at the beginning of the 8-week treatment period (see Fig. 1 p. 132). The reference teaches assessment of the efficacy of treatment by measuring the MADRS score as well as by the CGI severity and improvement scale (see pp. 130 and 134).

Patris et al. do not teach escitalopram (the S-enantiomer) specifically.

Boegesoe et al. teach that antidepressant drug citalopram has two enantiomers, (+)-citalopram (which is escitalopram) and (-)-citalopram, and that the entire 5-HT uptake inhibition activity resides in the (+) enantiomer (i.e. escitalopram) (see: abstract; col. 1, lines 1-28; col. 2, lines 9+). The reference also teaches separation of the two enantiomers to yield pure citalopram enantiomers (see col. 2, lines 51 - col. 7, line 25). The reference teaches, "a method for alleviating depression in a living animal body subject thereto" by administering an effective amount of the compound or pharmaceutically acceptable salts (which is escitalopram), at dosages ranging from 0.10-100 mg and preferably 5-50 mg daily (overlapping the dosage of current claim 25). (See: abstract; col. 8 Table 1; col. 8, lines 55-66; claims 1-2 & 7-12).

While Boegesoe et al. teach pharmaceutically acceptable salts; the reference does not teach oxalate salts specifically.

The deficiency of Boegesoe is resolved by the teachings of Maisey.

Maisey teaches a method of relieving or preventing depression in warm-blooded animals, including man, which comprises administering thereto an anti-depressant effective amount of a compound of the formula: ##STR36## wherein R.sup.1 is hydrogen or halogen, or alkyl or alkoxy of 1 to 3 carbons; A is a radical of the formula: ##STR37## wherein R.sup.2 and R.sup.3, which may be the same or different, are hydrogen or alkyl of 1 to 3 carbons and B is oxygen; and the non-toxic, pharmaceutically-acceptable acid-addition salts thereof in association with a major amount of a non-toxic, pharmaceutically-acceptable diluent or carrier (col. 16, l. 42)

Maisey teaches an embodiment which suggests and supports that conversion to a crystalline oxalate salt is a standard **procedure** (col. 9, l/s 56 and 57)

Maisey does not teach escitalopram but it does teach an agent indicated for treating depression.

Thus, it would have been *prima facie* obvious to one of ordinary skill in the art to use the oxalate or crystalline oxalates salt of escitalopram in the instantly claimed method of treating severe depression, having been taught by the prior art that it is known to make oxalate and crystalline oxalate salts of a racemic compound to obtain the (S) isoform and motivated by the desired to obtain the (S)/(+) isoform salt of citalopram (i.e. escitalopram), which is known to be the racemate wherein the pharmaceutical antidepressant activity resides. Patris establishes the fact that within citalopram is contained the (S)-enantiomer which is escitopram. Boegesoe definitively teaches the subject matter of the claimed invention, because Boegesoe addresses and encompasses the bioactive agent and dosage parameters of the claimed invention. Further, based on the teachings of Maisey the conversion of a compound indicated for depression to a more pure compound is disclosed as a standard procedure. As mentioned before, the limitations of the instant claims drawn to a salt species are functional language and hold no patentable weight in view of claimed invention.

Claims 21, 23, 27, 31, 33, and 37 are rejected. No claims are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy E. Betton whose telephone number is (571) 272-9922. The examiner can normally be reached on Monday-Friday 8:30a - 5:00p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Shengjun Wang/
Primary Examiner, Art Unit 1617

TEB